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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/823,767

03/30/2001

Yuichi Shibazaki

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6449

7590

06/07/2004

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EXAMINER

COLLINS, DARRYL J

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,767

Applicant(s)

SHIBAZAKI, YUICHI

Examiner

Darryl J. Collins

Art Unit

2873

aw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-35 and 39-44 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 23-25, 27 and 29 is/are rejected.
- 7) ☒ Claim(s) 3-22, 26, 28 and 36-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 12, 2004 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 23-25, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacich (USPN 4733945) in view of Watson et al (USPN 6239924). Bacich teaches an optical holding device having an outer member (Figure 17, element 180), an inner member (Figure 17, element 175) communicated with an outer edge portion of an optical element (Figure 17, element 185) and a drive element provided with the outer member ((Figure 17, element 184) as claimed in independent claims 1 and 29. Bacich also teaches an optical holding device using the mounts as discussed above for use in a multiple lens mounting system (column 3, lines 61-

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65) wherein the outer member of the mount holds a second optical element (Figure 1, element 86) as claimed in dependent claim 2, a return mechanism (Figure 17, element 184) as claimed in dependent claim 23, means to connect a secondary outer portion to the outer edge portion of the first optical holder (Figure 1, elements 10, 11 and 12) as claimed in dependent claim 24, the outer ring having a cylindrical wall having an opening wherein the actuator is located in the opening (Figure 17) as claimed in dependent claim 25 and wherein the outer ring has two ends with at least one of the ends providing for a mounting portion (Figure 17) as claimed in dependent claim 27. Although Bacich fails to teach a drive mechanism as claimed in independent claims 1 and 29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a drive mechanism to electrically drive the mechanical drive element of Bacich, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192. Bacich also fails to teach an inner member monolithically formed with an outer member as claimed in independent claims 1 and 29. Watson et al does teach an optical element holding device having an inner wall (Figure 2A, element 32) and an outer wall wherein the mounting element (Figures 2A and 2B, element 24) can be machined from a precision material (column 4, lines 44-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well known unitary construction of an optical holder of Watson et al with the optical holding mount of Bacich to increase focusing accuracy.

Response to Arguments

Applicant's arguments filed April 12, 2004 have been fully considered but they are not persuasive. The monolithically formed optical holder does not patentably distinguish over the prior art as cited above. As to the Applicant's argument that the examiner failed to address the drive mechanism, please note that the incorporation of an automated function to perform the same function as a mechanical function has been held to not be patentably distinct over the prior art (please see the rejection above).

Allowable Subject Matter

Claims 30-35 and 39-44 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Claims 30-35 and 39-44 are allowed for reasons as set forth in the Office action mailed March 3, 2003.

Claims 3-22, 26, 28 and 36-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Neil et al teaches an optical holding apparatus having a drive mechanism.

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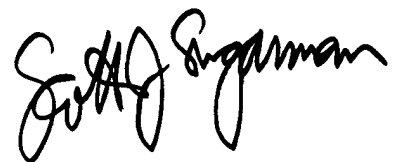
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darryl J. Collins whose telephone number is 571-272-2325. The examiner can normally be reached on 6:30 - 5:00 Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



djc



Scott J. Sugarman
Primary Examiner